

### **REMARKS/ARGUMENTS**

Claims 1-12 are pending in the present application. Claims 1, 2, 3 and 8 are amended. The amendments are all entirely supported by the application as originally filed and thus they do not add any new matter into the application. In particular, the amendments to claims 1 and 8 are supported, *inter alia*, by the disclosure at p. 5, lines 1-9, of the specification. Entry of the claim amendments into the file of the application is respectfully requested.

#### **Domestic Benefit**

Applicants' representative respectfully submits that the Examiner's statement on p. 2 of the Office Action, i.e., to the effect that applicants had not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §365(c), is incorrect. Applicants' representative telephoned the Examiner on December 7, 2009 to discuss this matter with him. Applicants' representative subsequently received a telephone call from the Examiner wherein the Examiner stated that he had discussed the matter with the Primary Examiner of this application and that applicants and their representative should ignore all after the first sentence of the "Domestic Benefit" discussion, i.e. such that applicants' claim for the benefit of the prior-filed International application is acknowledged by the Examiner without objection thereto. The Examiner is, therefore, respectfully requested to confirm applicants' right to the domestic benefit in his next Communication regarding this application.

#### **Foreign Priority**

Applicants' representative also respectfully submits that the Examiner's rejection of their claim to foreign priority at p. 2 of the Office Action is also not supported. This holding also was discussed with the Examiner during the December 7, 2009 telephone call noted above and the Examiner thereafter instructed applicants' representative, following the Examiner's discussion of the matter with the Primary Examiner, to ignore all after the first sentence of the "Foreign Priority" discussion, such that applicants' claim to the March 19, 2004 priority of their German application no. 10 2004 014 020.0 is acknowledged without objection thereto. The Examiner is

additionally requested to confirm applicants' right to the foreign priority in his next Communication with regard to the present application.

### **Claim Rejections Under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph**

Claims 2-3 and 8-12 are rejected under 35 U.S.C. §112, second paragraph for the reasons set forth on p. 3 of the Office Action.

In response to the rejection of claim 2, the term "substantially" has been deleted from the claim.

In response to the rejection of claim 3, the recitation regarding "derivatives" has been deleted from the claim.

The Office Action alleges (p. 3) that the word "including" is indefinite because it implies an incomplete listing, and it is unclear what steps or what elements have been left out. While applicants respectfully disagree with the characterization of the term "including", in order to advance the progress of this application claim 8 has been amended in a manner which is believed to overcome the rejection.

The Examiner is respectfully urged to reconsider and withdraw the rejection of claims 2, 3 and 8 under 35 U.S.C. §112, second paragraph. Further according to the Office Action (p. 3) claims 9-12 are each rendered indefinite for being dependent on an indefinite claim. However, since claims 2, 3 and 8 are believed to be no longer indefinite due to the amendments described above, the rejection of claims 9-12 is also deemed to have been overcome and should be withdrawn as well.

### **Claim Rejections Under 35 U.S.C. §102**

Claim 1 is rejected under 35 U.S.C. §102(b) on p. 4 of the Office Action as being allegedly anticipated by the Vatter et al. U.S. Patent Application Publication No. 2002/0018790 ("Vatter"). The rejection is respectfully traversed.

In response to the rejection, independent product claim 1 (as well as independent method claim 8) have been amended so as to recite that the protective coating of silicon dioxide serves to isolate the titanium dioxide constituent of the subject effect pigments from its environment to

prevent breakdown of, e.g., the UV absorber constituent of the claimed UV-protective cosmetic preparation.

Turning now to a discussion of the reference cited to reject claim 1, applicants submit that Vatter does not disclose multi-layer interference pigments, such as those included in the claimed UV protective cosmetic composition, with a SiO<sub>2</sub> layer that isolates a titanium dioxide component of the pigment from its environment to prevent the breakdown of a UV absorber component(s) of the pigment. At paragraph [0088] of the subject reference, in the penultimate line, the authors disclose “titanated mica”. Applicants assume that the Examiner is interpreting this term as referring to a mica substrate coated with TiO<sub>2</sub>. However, when this TiO<sub>2</sub> coated mica is used in a cosmetic composition such as is presently claimed, the TiO<sub>2</sub> will induce a photocatalytic composition of components of the cosmetic composition when the composition becomes irradiated by sunlight. It is in order to prevent this photocatalytic reaction, therefore, that the applicants prepare an effect pigment which is added into the cosmetic preparation wherein the pigment comprises a protective SiO<sub>2</sub> layer. Since at least this feature of the claimed invention is not taught, either literally or inherently, by the Vatter reference, applicants submit that independent claim 1 is not anticipated by the reference. Therefore the Examiner is respectfully requested to reconsider and withdraw the anticipation rejection of claim 1 based on Vatter.

#### **Claim Rejections Based on 35 U.S.C. §103**

Claims 1-12, i.e., all of the claims pending in the application, are rejected under 35 U.S.C. §103 on p. 5 over Vatter et al. in view of USP 6,596,070 of Schmidt et al. The rejection is respectfully traversed.

In response to the rejection, both of the independent claims 1 and 8 pending in the application have been amended, as noted above, to specify *inter alia* that the protective coating, which is formed of silicon dioxide, isolates the TiO<sub>2</sub> layer from the environment surrounding the pigment. This serves, as also mentioned above, to prevent the breakdown of various components of the claimed cosmetic preparation, e.g., the UV absorbers. This same feature is, therefore, also included in claims 2-7 and 9-12 due to their dependency on, respectively, claims 1 and 8.

As the rejection is based on the combination of Vatter and Schmidt, applicants respectfully direct the Examiner's attention to the comments above with regard to the distinctions of the claimed cosmetic preparation over Vatter, which remarks are also specifically incorporated by reference into this discussion of the rejection under §103.

With specific reference to the Schmidt patent, applicants submit that Schmidt discloses pigments having a SiO<sub>2</sub> coating. However, the SiO<sub>2</sub> coating disclosed in the reference is only used as a low refractive layer which is arranged between two TiO<sub>2</sub> coatings (see, e.g., col. 4, line 20 to 24 and claim 1). At col. 4, line 25 a 'final coating' is mentioned.

Schmidt, however, does not provide any detail with regard to the composition or nature of this final coating. Therefore, one having an ordinary level of skill in this art would not obtain any incentive from the Schmidt reference to apply an SiO<sub>2</sub> protective layer(s) for the purpose of isolating TiO<sub>2</sub> from its surroundings, i.e., in order to prevent photocatalytic decomposition of components of the claimed UV-protective cosmetic preparation.

Further to the above, not only does Schmidt not teach or suggest the formation of an SiO<sub>2</sub> protective layer, but neither would the combination of Schmidt and Vatter suggest this claimed feature. Vatter et al. discloses (paragraph [0090]) multilayer interference pigments. When starting from the disclosure of Vatter and taking into account the disclosure contained in Schmidt, one of ordinary skill in this art would tend toward multilayered pigments as disclosed, for example at col. 4, lines 18-25. However, the subject reference provides no teaching or suggestion, at the indicated location or anywhere else for that matter, to form such a pigment having a protective coating of SiO<sub>2</sub>.

Schmidt only discloses that SiO<sub>2</sub> is a suitable low-reflectance layer, the presence of which is necessary to obtain a desired pearlescent effect in the multi-layered pigments. Neither Vatter nor Schmidt address the problem of photocatalytic induced decomposition of UV absorbers in a UV-protective cosmetic composition, it cannot be said that either reference, or both taken together, would suggest to one skilled in this art how to solve a problem that neither of them recognized.

For the reasons provided above, therefore, applicants respectfully submit that none of claims 1-12 would be obvious over the combined disclosure of Vatter and Schmidt. The Examiner is, therefore, requested to reconsider and withdraw the rejection of the subject claims under 35 U.S.C. §103.

### **Information Disclosure**

Attached at the end of the present Office Action is, *inter alia*, a copy of a form entitled, "Applicant's Art Citation" listing various references applicants wished to bring to the Examiner's attention upon the filing of the present application. A number of the references are lined through and the form bears the statement, "All References Considered Except Where Lined Through. /D.B./". Applicants assume that the lined through references were not considered due to the fact that they are in a language other than English.

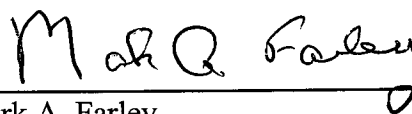
Submitted with this response, therefore, is a form citing - for each of the references lined out by the Examiner on the original listing - either an English-language corresponding reference (where available) or at least an English-language Abstract. Copies of the corresponding references and Abstracts are, of course, also being provided with this response. The Examiner is respectfully requested to consider each of these and to make the references of record in the present application by initialing and dating the attached listing and returning a copy of the form to applicants' representative with his next Communication regarding this application.

No fee is believed to be due with this submission. However, should any fee be due the Office is authorized to charge the required fee to Deposit Account No. 15-0700.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE PATENT AND  
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Respectfully submitted,



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